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EXAMINER

HANEY, RICHAE LEE

ART UNIT PAPER NUMBER

3765

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,087

Applicant(s)

KANITZ, VICTORIA ANN

Examiner

Richale L. Haney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: Ear Covering and Scarf Combination.

Claim Objections

2. Claims 1 and all dependent claims are objected to because of the following informalities: the claim language indicates that there are a plurality of both elongated hourglass members and rectangular members. According to the drawings and specification it appears that there is only one elongated hourglass member and one rectangular member. Appropriate correction is required.

3. Claim 4 is objected to because of the following informalities: the claim should be in one sentence format. Appropriate correction is required.

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4. Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. All the limitations in this claim have been previously set forth.

Claim Rejections - 35 USC § 112

5. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "the" in reference to plurality of elongated fabric member. There is insufficient antecedent basis for this limitation in the claim. A first plurality of elongated fabric member and second plurality of elongated fabric member has been positively recited in the claims. However, the plurality of elongated fabric member does not indicate which member the applicant is referring to and renders the claim indefinite and unclear.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beck (US 2,021,144) in view of Williams (US 3,668,707). The device of Beck shows a device covering a central portion of a wearer's head, extending down and over the ears and encircling the wearer's neck (Figure 1). However, the device does not disclose an elongated fabric member covering the ears to be in an hourglass shape. The applicant does not provide specific information regarding the benefit of utilizing the claimed shape and any shape that would protect the ears would be suitable. The device of Williams discloses the use of an elongate hourglass material for covering the ears and a central portion of the head with opposite side edges, a front and back edge, intermediate portion and opposite end portions having angles of unequal lengths (Figure 7). The designation of the front and back portions are not specifically disclosed; however, it would be obvious to one of ordinary skill in the art to reverse the location of front and back if desired. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Beck by using an hourglass shape to cover the ears of the wearer as taught by Williams in order to achieve a greater coverage area.

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9. Claims 2, 5, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beck and Williams as applied to claim 1 above, and further in view of Danelz (2,462,727) and Grant (US 3,088,119). The modified device of Beck shows all of the claimed invention except for a second elongate fabric member with opposite portions of a reduced width and scarf connected to a headband at spaced points. The device of Danelz shows a generally rectangular neck scarf for covering and individuals neck in traditional scarf manner (Figure 1) configured having opposite side edges, a front and back portion, an intermediate portions, and opposite end portions in a reduced manner (Figure 3, 6). Grant shows a headwear member (Figure 5, B) with a neck encircling scarf member attached to the headwear member at spaced points (Figure 5, 18 and 11) creating an opening for the wearer's head at an intermediate portion of the head covering (Figure 5). The opening at the center portions defines a back opening of the headband (B) and the neck encircling scarf portion (A) resulting in a double band with a headband that partially covers the wearers head, leaving the face exposed (Figure 5). The scarf member of Grant comprises attached members at each end for wrapping around the neck of the wearer (Figure 3, 17 and 18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the device of Beck by incorporating a scarf member with reduced end portions, attachment means at opposing ends, and spaced attachments to a headband as taught by Grant and Danelz in order to secure the device to the wearer and protect both the neck and the head of the wearer.

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10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified device of Beck as applied to claims 1 – 3 above, and further in view of Wolfe. The modified device of Beck shows all of the claimed invention except for a passageway inserted between an intermediate portion and one of the opposite end portions of a scarf and the scarf is inserted into the passageway. The device of Wolfe shows a scarf (Figure 1, 10) with a passage way between an intermediation portion and an between an opposing opposite end portion (Figure 2, 22 and 26) whereby the scarf is passed through opening to provide an adjustment means (Figure 1). The device does not specifically disclose that the scarf is capable of being worn in reverse; however, it is an inherent feature of the claimed invention. It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the device of Beck by including a passageway for size adjustment as taught by Wolfe in order to achieve a non expensive method of manufacturing an non complex adjustment means (Column 1, lines 26 – 30).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

James (D 92,603) shows two scarf like members adjoined.

Murphy (US 6,065,156) and Yang (D 396,338) show various size adjustment means.

Williams (US 6,185,749) shows a ear covering with scarf portion attached.

Rosaen (US 4,654,897) shows a scarf with opposing ends reduced in size.

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Tuttle (US 145,977), Frenchmann et al. (US 3,935,597) and Kahl (US 5,144,696) show various scarf and head covering devices.

Notice to Pro Se Applicant

1. An examination of this application reveals that applicant is unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

1. In response to this Office Action, Applicant is referred to chapter 714 of the Manual of Patent Examining Procedures (MPEP).

For applicant's reference, sections of chapter 714 are recited below: (for more details, applicant is advised to review chapter 714 for a complete text):

2. Applicant is reminded that MPEP 714 states:

714 Amendments, Applicant's Action

37 CFR 1.115. Amendment.

The applicant may amend before or after the first examination and action and also after the second or subsequent examination or reconsideration as specified in 1.112 or when and as specifically required by the examiner. The patent owner may amend in accordance with 1.510(e) and 1.530(b) prior to reexamination, and during reexamination proceedings in accordance with 1.112 and 1.116.

See also MPEP @ 714.12.

For amendments in reexamination proceedings see MPEP @ 2250 and @ 2266.

3. Applicant is reminded that the Amendment should be signed. MPEP 714.01 also states: 714.01 Signatures to Amendments

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To facilitate any telephone call that may become necessary, it is recommended that the complete telephone number with area code and extension be given, preferably near the signature. Note MPEP @ 605.04 to @ 605.05(a) for a discussion of signatures to the application.

4. Applicant is reminded what is in a response to the Office Action. MPEP 714.02 states:

714.02 Must Be Fully Responsive

37 CFR 1.111. Reply by applicant or patent owner.

(a) After the Office action, if adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply thereto and may request reconsideration or further examination, with or without amendment.

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must make request therefor in writing. The reply by the applicant or patent owner must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office action. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the case to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections. (See 1.135 and 1.136 for time for reply.)

In all cases where response to a requirement is indicated as necessary to further consideration of the claims, or where allowable subject matter has been indicated in an application, a complete response must either comply with the formal requirements or specifically traverse each one not complied with.

Drawing and specification corrections, presentation of a new oath and the like are generally considered as formal matters. However, the line between formal matter and those touching the merits is not sharp, and the determination of the merits of a case may require that such corrections, new oath, etc., be insisted upon prior to any indication of allowable subject matter.

37 CFR 1.119. Amendment of claims.

The claims may be amended by canceling particular claims, by presenting new claims, or by rewriting particular claims as indicated in 1.121. The requirements of 1.111 must be complied with by pointing out the specific distinctions believed to render the claims patentable over the references in presenting arguments in support of new claims and amendments.

An amendment submitted after a second or subsequent non-final action on the merits which is otherwise responsive but which increases the number of claims drawn to the invention previously acted upon is not to be held non-responsive for that reason alone. (See 37 CFR 1.112, MPEP @ 706.)

The prompt development of a clear issue requires that the responses of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP @ 706.03(n).

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An amendment attempting to "rewrite" a claim in the manner set forth in 37 CFR 1.121(b) may be held non-responsive if it uses parentheses, (), where brackets, [], are called for; see MPEP @ 714.22.

Responses to requirements to restrict are treated under MPEP @ 818.

5. Applicant is reminded the procedure to make Amendments

714 [R-1] Amendments, Applicant's Action

37 CFR 1.121. Manner of making amendments in application.

(a) Amendments in applications, other than reissue applications. Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(b) Specification other than the claims and listings provided for elsewhere (§§ 1.96 and 1.825) . -

(1) Amendment by instruction to delete, replace, or add a paragraph. Amendments to the specification, other than the claims and listings provided for elsewhere (§§ 1.96 and 1.825), may be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a deleted paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) Any replacement or added paragraph(s) in clean form, that is, without markings to indicate the changes that have been made; and

(iii) Another version of any replacement paragraph(s), on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of the paragraph(s). The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added paragraph or a deleted paragraph as it is sufficient to state that a particular paragraph has been added, or deleted.

(2) Amendment by replacement section. If the sections of the specification contain section headings as provided in §§ 1.77(b), 1.154(b), or § 1.163(c), amendments to the specification, other than the claims, may be made by submitting:

(i) A reference to the section heading along with an instruction to delete that section of the specification and to replace such deleted section with a replacement section;

(ii) A replacement section in clean form, that is, without markings to indicate the changes that have been made; and

(iii) Another version of the replacement section, on one or more pages separate from the amendment, marked up to show all changes relative to the previous version of the section. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system.

(3) Amendment by substitute specification. The specification, other than the claims, may also be amended by submitting:

(i) An instruction to replace the specification;

(ii) A substitute specification in compliance with § 1.125(b); and

(iii) Another version of the substitute specification, separate from the substitute specification, marked up to show all changes relative to the previous version of the specification.

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The changes may be shown by brackets (for deleted matter), or underlining (for added matter), or by any equivalent marking system.

(4) Reinstatement : Deleted matter may be reinstated only by a subsequent amendment presenting the previously deleted matter.

(c) Claims. -

(1) Amendment by rewriting, directions to cancel or add . Amendments to a claim must be made by rewriting such claim with all changes (e.g, additions, deletions, modifications) included. The rewriting of a claim (with the same number) will be construed as directing the cancellation of the previous version of that claim. A claim may also be canceled by an instruction.

(i) A rewritten or newly added claim must be in clean form, that is, without markings to indicate the changes that have been made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added (e.g., "amended, " "twice amended, " or "new ").

(ii) If a claim is amended by rewriting such claim with the same number, the amendment

must be accompanied by another version of the rewritten claim, on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of that claim. A parenthetical expression should follow the claim number indicating the status of the claim, e.g., "amended, " "twice amended, " etc. The parenthetical expression "amended, " "twice amended, " etc. should be the same for both the clean version of the claim under paragraph (c)(1)(i) of this section and the marked up version under this paragraph. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added claim or a canceled claim as it is sufficient to state that a particular claim has been added, or canceled.

(2) A claim canceled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

(3) A clean version of the entire set of pending claims may be submitted in a single amendment paper. Such a submission shall be construed as directing the cancellation of all previous versions of any pending claims. A marked up version is required only for claims being changed by the current amendment (see paragraph (c)(1)(ii) of this section). Any claim not accompanied by a marked up version will constitute an assertion that it has not been changed relative to the immediate prior version.

(d) Drawings . Application drawings are amended in the following manner: Any change to the application drawings must be submitted on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval by the examiner, new drawings in compliance with § 1.84 including the changes must be filed.

(e) Disclosure consistency . The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

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(f) No new matter . No amendment may introduce new matter into the disclosure of an application.

(g) Exception for examiner 's amendments: Changes to the specification, including the claims, of an application made by the Office in an examiner 's amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner 's amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2) or (c)(1) of this section is not required.

(h) Amendments in reissue applications. Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

(i) Amendments in reexamination proceedings : Any proposed amendment to the description and claims in patents involved in reexamination proceedings in both ex parte reexaminations filed under § 1.510 and inter partes reexaminations filed under § 1.913 must be made in accordance with § 1.530(d)-(j).

(j) Amendments in provisional applications: Amendments in provisional applications are not normally made. If an amendment is made to a provisional application, however, it must comply with the provisions of this section. Any amendments to a provisional application shall be placed in the provisional application file but may not be entered.

I. >< WHEN APPLICANT MAY AMEND

The applicant may amend:

(A) before or after the first examination and action and also after the second or subsequent examination or reconsideration as specified in 37 CFR 1.112;

(B) after final rejection, if the amendment meets the criteria of 37 CFR 1.116;
and

(C) when and as specifically required by the examiner.

Amendments in provisional applications are not normally made. If an amendment is made to a provisional application, however, it must comply with the provisions of 37 CFR 1.121. Any amendments to a provisional application will be placed in the provisional application file, but may not be entered.

II. >< MANNER OF MAKING AMENDMENTS

After March 1, 2001, all amendments to the specification, including the claims, must be made by replacement paragraph/section/claim in clean form (without underlining and bracketing) in order to eliminate (1) the need for the Office to enter changes to the text of application portions by handwriting in red ink, and (2) the presence of hard to scan brackets and underlining to improve the patent publishing process. This practice requires the applicant to provide a clean copy of an amended paragraph/section/claim together with a marked up version using applicant's choice of a marking system showing the changes being made which will aid the examiner. The marked up version must be based on the mediate previous version and indicate (by markings) how the previous version has been modified to produce the clean replacement paragraph(s), section(s),

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specification or claim(s) submitted in the current amendment. "Previous version" is defined as the version of record in the application as originally filed or from a previously entered amendment.

Amendments to the Specification

In order to delete, replace or add a paragraph to the specification of an application, the amendment must unambiguously identify the paragraph to be modified either by paragraph number (see MPEP § 608.01), page and line, or any other unambiguous method and be accompanied by the replacement paragraph(s) in clean form. Where paragraph numbering has been included in an application as provided in 37 CFR 1.52(b)(6), applicants can easily refer to a specific paragraph by number when presenting an amendment. If a numbered paragraph is to be replaced by a single paragraph, the added replacement paragraph should be numbered with the same number of the paragraph being replaced. Where more than one paragraph is to replace a single original paragraph, the added paragraphs should be numbered using the number of the original paragraph for the first replacement paragraph, followed by increasing decimal numbers for the second and subsequent added paragraphs, e.g., original paragraph [0071] has been replaced with paragraphs [0071], [0071.1], and [0071.2]. If a numbered paragraph is deleted, the numbering of the subsequent paragraphs should remain unchanged.

37 CFR 1.121(b)(1)(ii) requires that the replacement or added paragraph(s) be in clean form. This means that the added or replacement paragraph(s) must not include any markings to indicate the changes that have been made. 37 CFR 1.121(b)(1)(iii) requires that a separate version of the replacement paragraph(s) accompany the amendment. The separate version must include each replacement paragraph with markings to show the changes relative to the previous version as an aid to the examiner. A marked up version, however, does not have to be supplied for any added paragraph(s) or any deleted paragraph(s), as it is sufficient to merely indicate or identify any paragraph that has been added or deleted.

Applicants are also permitted to amend the specification by replacement sections (e.g., as provided in 37 CFR 1.77(b), 1.154(b), or 1.163(c)). As with replacement paragraphs, the amended version of a replacement section is required to be provided in clean form, that is, without any markings to show the changes that have been made. A separate marked up version showing the changes in the section relative to the previous version must accompany the actual amendment as an aid to the examiner. Applicants are also permitted to amend the specification by submitting a substitute specification, provided the requirements of 37 CFR 1.125(b) are met. An accompanying separate marked up version showing the changes in the specification relative to the previous version is also required.

Any subject matter deleted by amendment can only be reinstated by a subsequent amendment presenting the previously deleted subject matter. A direction by applicant to remove a previously entered amendment will not be permitted.

Amendments to the Claims

All amendments to a claim must be presented in the form of a rewritten claim. Any rewriting of a claim will be construed as a direction to cancel the previous version of the claim. See *In re Byers*, 230 F.2d 451, 455, 109 USPQ 53, 55 (CCPA 1956) (amendment of a claim by inclusion of an additional limitation had exactly the same effect as if the claim as originally presented had been canceled and replaced by a new claim including that limitation). Any rewritten or newly added claim must be submitted in clean form, that is, with no markings to indicate the changes that have been made**. If a claim is amended by rewriting the claim with the same number, the amendment< must be accompanied by a marked up version separate

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from the amendment using applicant's choice of marking system to indicate the changes being made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added, e.g., "amended," "twice amended," or "new," in both the clean version and the marked up version. A marked up version does not have to be supplied for any added claims or any canceled claims. If a marked up version is supplied to show changes made to amended claims, however, applicant should identify (in the marked up version) any added or canceled claims with a statement, such as, "Claim 6 has been canceled." A canceled claim can be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

Applicants may submit a clean version (with no markings) of all of the pending claims in one amendment paper. Applicants may wish to consolidate all previous versions of pending claims from a series of separate amendment papers into a single clean version in a single amendment paper. Providing this consolidation of claims in the file will be beneficial to both the Office and the applicant for patent printing purposes. When rewriting a claim in the clean set, the parenthetical expression, if any, from the claim to be rewritten should not appear in the clean set. Thus, the only time a parenthetical expression should appear in the clean set is when a claim is being amended. See MPEP § 714.13 for submitting a clean set of claims under 37 CFR 1.116 and MPEP § 714.16 for submitting a clean set under 37 CFR 1.312. See also MPEP § 714.22(a).

It is recommended that the following format be used by applicants in complying with the revised amendment practice requirements. The amendment paper should include, in the following order:

- (A) a clean version of the amended (replacement) paragraph(s)/claim(s);
- (B) a remarks section (beginning on a separate sheet); and
- (C) a marked-up version (also beginning on a separate sheet) showing changes and clearly identified as "Version with markings to show changes made." The submission of a clean version of all pending claims shall be construed as directing the cancellation of all previous versions of any pending claims. A marked up version would only be needed for claims being changed by the current amendment (see 37 CFR 1.121(c)(1)(ii)). Any claim not accompanied by a marked up version will constitute an assertion that it has not been modified relative to the immediate prior version. Thus, if applicant is not making any amendments to the claims, but is merely presenting all pending claims in clean form, without any underlining and bracketing, a marked up version should not be submitted.

37 CFR 1.121(g) permits the Office to make amendments to the specification, including the claims, by examiner's amendments without paragraph/section/claim replacement in the interest of expediting prosecution and reducing cycle time. Additions or deletions of subject matter in the specification, including the claims, may be made by instructions to make the change at a precise location in the specification or the claims. See MPEP § 1302.04.

III. > REVISED MANNER OF MAKING AMENDMENTS

Effective January 31, 2003, the Office is permitting applicants to submit amendments in a revised format as set forth below. All applicants including applicants participating in the Office's electronic file wrapper prototype may submit amendments in reply to Office actions using the revised format. The Office's electronic file wrapper prototype program is described in "USPTO ANNOUNCES PROTOTYPE OF IMAGE PROCESSING," 1265 O.G. 87 (Dec. 17, 2002), and applies only to Group Art Unit 1634, 2827, and 2834.

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Waiver of 37 CFR 1.121

The provisions of 37 CFR 1.121(a), (b), (c), and (d) are waived for amendments to the claims, specification, and drawings in all applications in all Technology Centers where the amendments comply with the revised amendment format detailed below. The revised amendment format (and the waiver) does not apply to 37 CFR 1.121(h) and (i) which indicate that amendments to reissue applications and reexamination proceedings are governed by 37 CFR 1.173 for reissue applications and 37 CFR 1.530(d) - (k) for ex parte and inter partes reexaminations.

Revised Amendment Format

-Begin on Separate Sheets

Each section of an amendment (e.g., Claim Amendments, Specification Amendments, Remarks) shall begin on a separate sheet to facilitate separate indexing and electronic scanning of each part of an amendment document for placement in an electronic file wrapper. For example, each of the following four sections of an amendment paper must start on a separate sheet:

- (A) Introductory Comments;
- (B) Amendments to the Specification;
- (C) Amendments to the Claims;
- (D) Remarks.

-Two Versions of Amendment Part(s) No Longer Required

The current requirement in 37 CFR 1.121(b) and (c) to provide two versions (a clean version and a marked up version) of each replacement paragraph, section, substitute specification or claim will be waived where an amendment is submitted in the format noted below.

-Amendment to the Claim

Each amendment document that includes a change to an existing claim, or submission of a new claim, must include a complete listing of all claims in the application. After each claim number, the status must be indicated in a parenthetical expression, and the text of each claim under examination (with markings to show current changes) must be presented. The listing will serve to replace all prior versions of the claims in the application.

(A) The current status of all of the claims in the application, including any previously canceled or withdrawn claims, must be given. Status is indicated in a parenthetical expression following the claim number by one of the following: (original), (currently amended), (previously amended), (canceled), (withdrawn), (new), (previously added), (reinstated - formerly claim #_), (previously reinstated), (re-presented - formerly dependent claim #_), or (previously re-presented). The text of all pending claims under examination must be submitted each time any claim is amended. Canceled and withdrawn claims should be indicated by only the claim number and status.

(B) All claims being currently amended must be presented with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim should be shown by strikethrough (for deleted matter) or underlining (for added matter). An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended" will include markings.

(C) The text of pending claims not being amended must be presented in clean version, i.e., without any markings. Any claim presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version.

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(D) A claim may be canceled by merely providing an instruction to cancel. Listing a claim as canceled will constitute an instruction to cancel. Any claims added by amendment must be indicated as (new) and must not be underlined.

(E) All of the claims in each amendment paper must be presented in ascending numerical order. Consecutive canceled or withdrawn claims may be aggregated into one statement (e.g., Claims 1 - 5 (canceled)).

Example of listing of claims:

Claims 1-5 (canceled)

Claim 6 (withdrawn)

Claim 7 (previously amended): A bucket with a handle.

Claim 8 (currently amended): A bucket with a green blue handle.

Claim 9 (withdrawn)

Claim 10 (original): The bucket of claim 8 with a wooden handle.

Claim 11 (canceled)

Claim 12 (new): A bucket with plastic sides and bottom.

Claim 13 (previously added): A bucket having a circumferential upper lip.

Claim 14 (re-presented - formerly claim 11): A black bucket with a wooden handle.

-Amendments to the Specification

Amendments to the specification are to be made by presenting a replacement paragraph, section or substitute specification marked up to show changes made relative to the immediate prior version. The changes should be shown by strikethrough (for deleted matter) or underlining (for added matter). An accompanying clean version is not required and should not be presented.

-Amendments to the Drawing

Drawing changes must be made by presenting replacement figures which incorporate the proposed changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented in the remarks section of the amendment. If the changes to the drawing figure(s) are not approved by the examiner, applicant will be notified in the next Office action. Any replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing should not be labeled as "amended".

IV. < AMENDMENT IN REEXAMINATION PROCEEDINGS

In patent-owner-filed reexaminations, the patent owner may amend at the time of the request for reexamination in accordance with 37 CFR 1.510(e). In any reexamination proceeding, no amendment or response can be filed between the date of the request for reexamination and the order for reexamination. See 37 CFR 1.530(a). Following the order for reexamination under 37 CFR 1.525 and prior to the examination phase of a reexamination proceeding, an amendment may be filed only with the patent owner's statement under 37 CFR

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1.530(b). During the examination phase of the reexamination proceeding, an amendment may be filed:

- (A) after the first examination as specified in 37 CFR 1.112;
- (B) after final rejection or an appeal has been taken, if the amendment meets the criteria of 37 CFR 1.116; and
- (C) when and as specifically required by the examiner.

See also MPEP § 714.12.

For amendments in reexamination proceedings see MPEP § 2250 and § 2266.

714.01 Signatures to Amendments

An amendment must be signed by a person having authority to prosecute the application. An unsigned or improperly signed amendment will not be entered. See MPEP § 714.01(a).

6. Applicant is reminded the following from the MPEP in regards to a final rejection:

714.12 Amendments After Final Rejection or Action

37 CFR 1.116. Amendments after final action.

(a) After final rejection or action (1.113) amendments may be made canceling claims or complying with any requirement of form which has been made. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under 1.135.

(b) If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon showing of good and sufficient reasons why they are necessary and were not earlier presented.

(c) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in 1.198, or to carry into effect a recommendation under 1.196.

Once a final rejection that is not premature has been entered in a case, applicant or patent owner no longer has any right to unrestricted further prosecution. This does not mean that no further amendment or argument will be considered. Any amendment that will place the case either in condition for allowance or in better form for appeal may be entered. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(a). Ordinarily, amendments filed after the final action are not entered unless approved by the examiner. See MPEP @ 706.07(e), @ 714.13 and @ 1207.

The prosecution of an application before the examiner should ordinarily be concluded with the final action. However, one personal interview by applicant may be entertained after such final action if circumstances warrant. Thus, only one request by applicant for a personal interview after final should be granted, but in exceptional circumstances, a second personal

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interview may be initiated by the examiner if in his judgment this would materially assist in placing the application in condition for allowance.

Many of the difficulties encountered in the prosecution of patent applications after final rejection may be alleviated if each applicant includes, at the time of filing or no later than the first response, claims varying from the broadest to which he or she believes he or she is entitled to the most detailed that he or she is willing to accept.

714.13 [R-1] Amendments After Final Rejection or Action, Procedure

Followed

FINAL REJECTION - TIME FOR REPLY

If an applicant initially replies within 2 months from the date of mailing of any final rejection setting a 3-month shortened statutory period for reply and the Office does not mail an advisory action until after the end of the 3-month shortened statutory period, the period for reply for purposes of determining the amount of any extension fee will be the date on which the Office mails the advisory action advising applicant of the status of the application, but in no event can the period extend beyond 6 months from the date of the final rejection. This procedure applies only to a first reply to a final rejection. The following language must be included by the examiner in each final rejection:

A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

This wording is part of form paragraphs 7.39, 7.40, 7.40.01, 7.41, 7.41.03, and 7.42.09. Form paragraph 7.39 appears in MPEP § 706.07. Form paragraphs 7.40 and 7.40.01 appear in MPEP § 706.07(a). Form paragraphs 7.41, 7.41.03, and 7.42.09 appear in MPEP § 706.07(b).

For example, if applicant initially replies within 2 months from the date of mailing of a final rejection and the examiner mails an advisory action before the end of 3 months from the date of mailing of the final rejection, the shortened statutory period will expire at the end of 3 months from the date of mailing of the final rejection. In such a case, any extension fee would then be calculated from the end of the 3-month period. If the examiner, however, does not mail an advisory action until after the end of 3 months, the shortened statutory period will expire on the date the examiner mails the advisory action and any extension fee may be calculated from that date. In the event that a first reply is not filed within 2 months of the mailing date of the final rejection, any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the end of the reply period set in the final rejection.

Failure to file a reply during the shortened statutory period results in abandonment of the application unless the time is extended under the provisions of 37 CFR 1.136.

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ENTRY NOT A MATTER OF RIGHT

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(b) is expected in all amendments after final rejection. Failure to properly respond to the final rejection results in abandonment unless an amendment is entered in part (MPEP @ 714.20, items 3 and 4).

An amendment filed at any time after final rejection but before an appeal brief is filed, may be entered upon or after filing of an appeal provided the total effect of the amendment is to (1) remove issues for appeal, and / or (2) adopt examiner suggestions.

See also MPEP @ 1207 and @ 1211.

Address for Communications After Final Action7. **Applicant is reminded that any communication should be sent to the following address:**

Commissioner of Patents and Trademarks

Box: AF

Washington, D.C. 20231

Certificate of Mailing

7. **It is called to applicant's attention that if a communication is mailed before the response time has expired applicant may submit the response with a "Certificate of Mailing" which merely asserts that the response is being mailed on a given date. So mailed, before the period for response has lapsed, the response is considered timely.**

The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under the Rules. Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for response. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

A suggested format for a certificate follows.

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Certificate of Mailing I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner of Patents and Trademarks

Box: AF

Washington, D.C. 20231 on _____

(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Certificate of Transmission I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, (Fax No. (703) _____ - _____) on _____

(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richale L. Haney whose telephone number is 571-272-8689. The examiner can normally be reached on M-F 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John J. Calvert can be reached on 571 -272-4983. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Richale L. Haney
Patent Examiner
Art Unit 3765
October 19, 2005

RLH


JOHN J. CALVERT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700